

**REMARKS**

Claims 1-12 and 14 are pending in this application. Applicants request that submitted claims 1-12 and 14, which are believed be in condition for allowance, be reexamined in light of the amendments made herein.

**35 U.S.C. § 112, Second Paragraph**

On page 2 of the Office Action mailed December 29, 2004, the Office maintained its rejection of claims 1-12 and 14 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. *See* Office Action, 12/29/04, p. 2.

Specifically, the Office identified the use of terms “embryo cells,” “embryo tissue,” “transgenic plants cells,” “tissues,” and “transgenic plant material,” as unclear. *Id.* at 2-3. Applicants have amended claims 1 and 7 accordingly, and respectfully request that the rejection be withdrawn.

The Office stated that the use of the term “co-cultivation for a period of 1-12 days,” as recited in step (iii) of claims 1 and 7, is confusing because the beginning time for the co-cultivation is not given. *Id.* at 3. Applicants have amended claims 1 and 7 to make clear that the co-cultivation begins at the end of step (ii). Applicants respectfully request the rejection be withdrawn.

The Office rejected all claims as indefinite for the use of the term “preparation of Agrobacterium.” *Id.* at 3. Claims 1 and 7 have been amended to further clarify its meaning and respectfully request that the rejection be withdrawn.

The Office similarly rejected claim 2 for use of the phrase “and following this transformation, Allium tissue is regenerated by preferential selection.” *Id.* At the Office’s suggestion, this language has been deleted. *Id.* Applicants, therefore, respectfully request that the rejection be withdrawn.

Claims 10, 11, and 12 were rejected for lacking clarity. *Id.* at 4. Each claim has been amended according to the Office’s suggestion (*id.*) and thus, the Applicants respectfully request the rejections be withdrawn.

Lastly, the Office rejects claims 1 and 7 under 35 U.S.C. § 112, second paragraph, “as being incomplete for omitting essential steps, such omission amounting to a gap between the steps.” *Id.* Moreover, the Office states that “A time duration for coculture (see step(b)(i)), the step(s) of wounding, the light/dark growth conditions where relevant, are essential steps and need to be set forth in the claims.” *Id.* Applicants have amended claims 1 and 7 to further clarify its invention. For example, the duration for co-culturing, as noted above, has been clarified within the claims; the step of wounding, consistent with the specification at page 3 for instance, was added to claims 1 and 7; and the use of light or dark growth conditions are non-essential steps, which are known in the art and also previously incorporated by reference into the teaching of the invention (see e.g., specification at page 6, lines 3-4). It is Applicants’ belief that these clarifications obviate the Office’s rejection and add no new matter. Accordingly, the Applicants respectfully request this rejection be withdrawn.

#### **35 U.S.C. § 112, First Paragraph**

On page 6 of the Office Action mailed December 29, 2004, the Office states that “Applicant’s claims, as of this present amendment, are in much better condition.” Office Action,

12/29/04, p. 6. Applicants wish to thank the Office for its comments. In light of Applicants further clarifications to independent claims 1 and 7, based in part upon of Office's comments, Applicants respectfully request that the remaining rejections under 35 U.S.C. § 112, first paragraph, be withdrawn.

To the extent the Office maintains its rejection of claims 1-12 and 14 under 35 U.S.C. § 112, first paragraph as not being enabled (*id.* at 4-5) for Allium species other than cepa, the Applicants respectfully disagree, as previously argued, and submit for convenience a declaration by a present inventor. Importantly, that declaration contains a manuscript that was accepted for publication in *Plant Cell Reports* after the present outstanding Office Action of December 29, 2004, was filed. Applicants wish to highlight that the peer-reviewed publication demonstrates the successful use of the method set forth in the present application for the transformation of two additional Allium species, leek and garlic.

Finally, Applicants acknowledge the Office's comment distinguishing "all Allium species plants" as opposed to 'Allium cepa.'" *Id* at 5. In light of the amendments noted above, Applicants submit that at least the rejection to dependent claim 3, as previously presented, should be withdrawn. Dependent claim 3 is drawn to onion.

In light of the clarifying amendments to independent claims 1 and 7, Applicants respectfully request that the rejection under 35 U.S.C. § 112, first paragraph, for lack of enablement be withdrawn.

Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

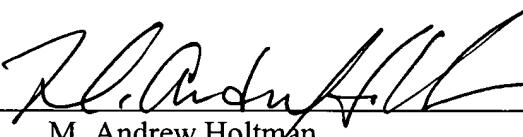
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: March 24, 2005

By:

  
M. Andrew Holtman  
Reg. No. 53,032